

## **REMARKS**

Claims 2-4 and 11 are cancelled, and claims 1, 12 and 15-17 have been amended in view of the Office Action and to better define what the Applicants consider their invention, as fully supported by an enabling disclosure.

Method claims 18-24 are new. Support for these new claims may be found in the specification as filed, more specifically in the claims as originally filed.

Reconsideration in view of the following remarks and entry of the foregoing amendments are respectfully requested.

Claims 1, 5-10 and 12-24 are pending.

## **SPECIFICATION**

The Examiner has requested that the trademarks ACULYN<sup>TM</sup> and LIPOSORB L-20<sup>TM</sup> be capitalized throughout the specification and accompanied by the generic terminology.

Applicant has amended the specification in using the generic terminology at the first occurrence of each one of the trademarks used, including TRIVALIN SF<sup>TM</sup> (the generic name of which is ethoxydiglycol, as found in paragraph numbered [0051] in the published application), and in capitalizing each trademark to distinguish it from common descriptive nouns. More details are given below in the section entitled "Rejections Under 35 U.S.C. § 112, Second Paragraph". Applicant submits that the identity of the products referred to by ACULYN 44, LIPOSORB L-20 and TRIVALIN is clear and that the use of such trademarks as it is now made in the amended specification respects their proprietary nature, in compliance with MPEP 608.01(v)I.

## **REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 1-17 have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

More specifically, the Examiner considered that the use of the expression "initial

viscosity” in claim 1 is an indefinite limitation. The Examiner also considered the use of the trademarks ACULYN 44 and LIPOSORB L-20 in claims 4, 15 and 17 indefinite, since a trademark allegedly only specifies the source of a material, not the nature of the material itself. The Examiner further contended that there was insufficient basis for the limitation “said oil” in claim 12 and considered, for the purpose of compact prosecution, that claim 12 depended on claim 10. The Examiner also considered the term “glycol-comprising phase” in claim 16 as unclear since “glycols may be miscible with water, and need not constitute a separate phase”. Action pages 2 and 3.

Applicant respectfully disagrees with the Examiner’s rejections. Claims 1-17, prior to any amendment made above, were not indefinite. However, in an effort to further the prosecution and secure prompt allowance, the claims were amended as follows.

Claim 1 has been amended to specify that the viscosity, formerly referred to as “initial”, is in fact the viscosity of the gel matrix “before application”, as stated in the description as filed in paragraph [0008] (paragraph [0010] in the published application).

Claim 4 has been deleted. The references to the trademarks ACULYN 44 and LIPOSORB L-20 as such have been deleted in claims 15 and 17.

More specifically, the claims are amended to replace the trademarks by the generic names of the corresponding products. Thus LIPOSORB L-20™ is replaced by “polysorbate 20”, as found in paragraph [0033] of the application as filed (i.e. paragraph [0049] of the published application); and ACULYN 44™ is replaced by its well-known and recognized CTFA (Cosmetics, Toiletry and Fragrance Association)/INCI (International Nomenclature Cosmetic Ingredient) name, that is to say PEG-150/Decyl Alcohol/SMDI Copolymer, wherein Applicant used full names of components instead of abbreviations (polyethylene glycol instead of PEG and saturated dicyclohexyl-methane diisocyanate instead of SMDI) for clarity of purposes.

Applicant respectfully submits that the use of such generic name for ACULYN 44™ in the specification does not amount to an addition of new subject-matter. Indeed, the INCI

name and meaning of ACULYN 44™ was well-known and satisfactorily defined in the literature before the filing date of the instant complete application on October 15, 2003, as evidenced by the enclosed publications. For example, the INCI name was available in a publication entitled “A Formulation Guide” by ISP dated April 2003, on page 22 out of 24 (in the stringing gel composition, phase B). The INCI name is also present in a Rohm and Haas publication entitled ACULYN™44 Rheology Modifier/ Stabilizer: An Excellent Thickener for Inorganic Sunscreen Formulations, which was apparently released in 2004 (page 4 out of 16), and in another Rohm and Haas publication dated 2005 (no month available), entitled ACULYN™44 Rheology Modifier Product Selection Guide (page 2 out of 2). Thus, Applicant submits that ACULYN 44™ clearly seems to have designated the same product, at least from July 2002 to date, that the well-known generic INCI name of ACULYN 44™ is adequate, clear and definite, and that the use of such generic name should therefore be permissible in the description and claims of the instant application.

Claim 12 has been amended to depend on claim 10 and to specify that the oil is a plant oil.

Claim 16 has been amended in specifying “glycol-containing solvent” and deleting any reference to phases, for clarity purposes.

Thus, Applicant submits that the rejections under 35 U.S.C. § 112, second paragraph are overcome.

In view of the above and foregoing, it is respectfully requested that the Examiner withdraw his rejection of claims 1-17 under 35 U.S.C. § 112, second paragraph.

#### **REJECTIONS UNDER 35 U.S.C. § 102**

Claims 1, 5-7 and 11 have been rejected as being anticipated by EP 0 625 034 B1 under 35 U.S.C. § 102(b).

Applicants respectfully disagrees with the Examiner’s rejection. However, solely in an effort to further the prosecution and secure prompt allowance, claim 1 is amended as noted

above, i.e. in specifying that the matrix gel comprises about 15% (w/w) polyethylene glycol-150/decyl alcohol/saturated dicyclohexyl-methane diisocyanate copolymer, which feature is clearly not disclosed in EP 0 625 034 B1. Applicant respectfully submits that this amendment to claim 1 essentially corresponds to the addition of the subject-matter of original claim 15, which was not rejected for anticipation.

Applicant respectfully requests that this rejection be withdrawn.

Claims 1-3, 5, 6 and 11 have been rejected as being anticipated by US 4,729,190 to Lee under 35 U.S.C. § 102(b).

Applicants respectfully disagrees with the Examiner's rejection. However, solely in an effort to further the prosecution and secure prompt allowance, claim 1 is amended as noted above, i.e. in specifying that the matrix gel comprises about 15% (w/w) polyethylene glycol-150/decyl alcohol/saturated dicyclohexyl-methane diisocyanate copolymer, which feature is clearly not disclosed in Lee.

Applicant respectfully requests that this rejection be withdrawn.

### **REJECTIONS UNDER 35 U.S.C. §103**

Claims 1-4 and 11 have been rejected as being rendered obvious by US 6,074,438 to Lim et al. under 35 U.S.C. § 103.

Applicants respectfully disagrees with the Examiner's rejection. However, solely in an effort to further the prosecution and secure prompt allowance, claim 1 is amended as noted above, i.e. in specifying that the matrix gel comprises about 15% (w/w) polyethylene glycol-150/decyl alcohol/saturated dicyclohexyl-methane diisocyanate copolymer, which feature is clearly not disclosed or suggested in Lim et al.

Applicant respectfully requests that this rejection be withdrawn.

Claims 6-10 and 12-14 have been rejected as being rendered obvious by EP 0 625 034 B1 in view of US 4,551,332 to Stillman, under 35 U.S.C. § 103.

Applicants respectfully disagrees with the Examiner's rejection. However, solely in an effort to further the prosecution and secure prompt allowance, claim 1 is amended as noted above, i.e. in specifying that the matrix gel comprises about 15% (w/w) polyethylene glycol-150/decyl alcohol/saturated dicyclohexyl-methane diisocyanate copolymer, which feature is clearly not disclosed or suggested in EP 0 625 034 B1 considered in view of Stillman.

Applicant respectfully requests that this rejection be withdrawn.

### Conclusion

The rejections of the original claims are believed to have been overcome by the present remarks and the introduction of new claims. From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such an action is earnestly solicited.

Respectfully submitted,

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